

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No. : 6,112,514
Issued : September 5, 2000
Application No. : 09/159,634
Filed : September 24, 1998
For : Fan Noise Reduction From Turbofan Engines Using Adaptive Herschel-Quincke Tubes

SUPPLEMENTAL DECLARATION OF MARK COBURN

I, Mark Coburn provide this Declaration in support of Petitioner's Request for Reconsideration of the Petition To Accept Delayed Payment of a Maintenance Fee Under 37 C.F.R. § 1.378(b) for U.S. Patent No. 6,112,514.

I hereby declare that:

1. I am employed by Virginia Tech Intellectual Properties, Inc. ("VTIP") (assignee of the above-identified patent).
2. I have read the 23 October 2012 Decision of the USPTO (Decision) dismissing Petitioner's Petition. The Decision at page 6 of 11 states in part that "Previous to 01 May 2008 the law firm of Whitham, Curtis, Christofferson & Cook P.C. (Whitham law firm) 'was responsible for tracking and payment of maintenance fees for VTIP patents.'" The Decision is quoting from paragraph 5 of my Declaration (provided with the filing of the Petition on 23 January 2012). By way of clarification, the Whitham firm was responsible for tracking patent maintenance fees up to about 01 May 2008 and they were responsible for payment of maintenance fees, but only after receipt of instructions from me to pay a maintenance fee that was due. As indicated in my Declaration,

I was responsible for ordering payment of the maintenance fees for VTIP patents. I do not recall and can find no record of ordering payment of the '514 second maintenance fee but I have inquired to be sure that I had not ordered payment. A Declaration of Michael Whitham at Whitham, Curtis, Christofferson & Cook P.C. accompanies the petition and explains that a search of the files of Whitham, Curtis, Christofferson & Cook P.C. confirms that their files contain no evidence of receipt of instructions to pay the second maintenance fee for the '514 patent. (Coburn Declaration, paragraph 13.)

Accordingly, no one at the Whitham firm was responsible for payment of the second maintenance fee for the '514 patent because no instructions to pay the second maintenance fee for the '514 patent had been sent to the Whitham firm. Until instructions were received at the Whitham firm to pay the second maintenance fee for the '514 patent no one at the Whitham firm was responsible for payment of this fee. Accordingly, there is no one at the Whitham firm to identify as responsible for payment of the second maintenance fee for the '514 patent.

3. The Decision at page 7 of 11 asks whether the docketing error by Debra Lucas was made during the period of time the Whitham Law firm was responsible for tracking and payment or whether it was made during the period of time VTIP was responsible for tracking and payment.

VTIP has tracked the '514 patent during its prosecution as an application (before it was issued as a patent) and afterwards. The Whitham Law firm was never responsible for payment of the second maintenance fee for the '514 because VTIP was tracking this and did not instruct the Whitham firm to pay the second maintenance fee. The docketing error resulted from (as explained in Debra Lucas' declaration) her entry of "Paid 8/9/06" which occurred at the same time she initialed the 09 August 2006 letter from Michael Whitham to Mark Coburn (Exhibit B of the 23 January 2012 petition) indicating that the Whitham firm had authorized payment of the European patent application annuity fee for VTIP Ref. 97.058. This erroneous entry occurred on or about 09 August 2006. This erroneous entry could not have occurred later than June of 2007 since that is when Debra Lucas left employment at VTIP (see Debra Lucas declaration at paragraphs 2 and 3).

4. The Decision at page 7 of 11 asks why the maintenance fee was not submitted during the period of time when the responsibility of tracking the maintenance fee rested with the Whitham Law firm. As explained at paragraph 13 of my declaration filed with the 23 January 2012 petition, I did not order the Whitham firm to pay the maintenance fee and Michael Whitham confirmed (in his declaration filed with the petition on 23 January 2012) that the Whitham firm did not receive instructions to pay the maintenance fee.

5. At page 8 of 11 of the Decision it is asked what notification might have been provided to VTIP from the Whitham firm of the need to submit the maintenance fee. VTIP has its own tracking system (the Inteum C/S tracking system) and had the ability to track the '514 patent. Because VTIP was tracking the '514 patent and because VTIP was assuming responsibility for payment of maintenance fees, the Whitham firm did not notify VTIP of the need to submit the second maintenance fee for the '514 patent.

6. Pages 8-10 of 11 of the Decision lists eleven reasons regarding establishment of the docketing error. The accompanying Request For Reconsideration... responds to each of these eleven reasons. In this regard it is hereby stated as follows:

The error that was the cause of the delay is the erroneous entry of "Paid 8/9/06" by Debra Lucas. This error resulted from her noting the 09 August 2006 letter from Michael Whitham (copy filed with the 23 January 2012 petition) informing of payment of the EP annuity wherein she erroneously docketed "Paid 8/9/06" for the US '514 patent rather than for the European application. At the time of the error (on or about 8/9/06) Debra Lucas and I were the only persons responsible for entry of information into the VTIP tracking system (the Inteum C/S system used at VTIP). I believe Debra Lucas made the erroneous "Paid 8/9/06" entry and Debra (in her declaration filed with the 23 January 2012 petition) confirms that "I erroneously entered the "Paid 8/9/06" entry on the VTIP Inteum C/S tracking report of the '514 patent (copy attached as Exhibit A) and I erroneously entered the "Paid 8/9/06" entry on the Inteum C/S IP Assets screen shot for Tech ID 97.058." (Debra Lucas declaration at paragraph 8.) This erroneous "Paid 8/9/06" entry is the error that caused the failure to pay the second maintenance fee for the '514 patent. As stated in my declaration (filed with the 23 January 2012 petition) "If the "Paid 8/9/06" indicator had not been in the record I believe I would have ordered payment of the US maintenance

fees and the '514 patent would not have expired. I believe Debra Lucas made the erroneous "Paid 8/9/06" entry...." After taking over maintenance fee payment responsibilities (on or about 01 May 2008) I regularly (at least monthly) reviewed the due dates for maintenance fees to ensure timely payment and did so during the time the second maintenance fee for the '514 patent could have been paid with a surcharge (i.e., up to 05 September 2008) but the erroneous "Paid 8/9/06" entry led me to believe that the second maintenance fee for the '514 patent had been paid and therefore need not be paid.

7. As to the unidentified error "that was the cause of the delay at issue in regards to the Whitham law firm," (reason No. 1 at page 8 of 11 of the Decision) there was no error at the Whitham law firm that was the cause of the delay at issue. Regarding the docket system at the Whitham firm, the Whitham docketing system was not relevant to the delay in payment of the second maintenance fee for the '514 patent because VTIP was responsible and Whitham was not responsible for tracking or payment. No one at the Whitham firm and no tracking system at the Whitham firm was responsible for payment of the '514 second maintenance fee. VTIP's tracking system (the Inteum C/S system) has been described and a copy of the tracking report for the '514 patent is included with the 23 January 2012 petition at Exhibit A.

8. Regarding Debra Lucas training and supervision (reason Nos. 8-11 at page 10 of 11 of the Decision), Debra was fully trained in use of the Inteum C/S system at VTIP and she had responsibility for other patent related tasks including communications with inventors, attorneys and the USPTO. Debra reported directly to me and as Debra's supervisor I hereby attest that I periodically reviewed her work and found it to be of the highest quality. Debra received information about any process changes or possible changes, e.g., notices from Inteum about possible changes to the Inteum C/S system and she was adept at understanding such notices and implementing anything new when required. Debra's work was regularly reviewed by me and she had regular (at least annual) performance evaluations. Debra did not make mistakes and any patterns of error would have been noticed. None were.

9. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Mark Coburn

Mark Coburn

12-20-12

(date)